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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,913	05/02/2001	Elliot Klein	103413a	6838

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EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,913

Applicant(s)

KLEIN, ELLIOT

Examiner

Michael J Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/2/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

Claims 1-20 of this application conflict with claims 1-20 of Application No. 09/833,273. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,259,367. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a lost and found system and method using RFID tags, customer information on the tag, the manufacturer storing the

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information, offering a reward for found objects, charging the owner for the reward and any shipping fees. The patent does not specifically mention, "...providing said data to a manufacturer or other warrantor in order to..." However, it is inherent that returning the information would allow to manufacturer to register a warranty.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no technological innovation necessary for the operation of the invention. Claim 1 could be met merely by putting a name-tag on an owned object with return instructions and the promise of a reward and mailing the information to the maker of the object.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the limitation "said warranty" in lines 9 and 10. There is insufficient antecedent basis for this limitation in the claim.

Further in claim 1, the body of the claim is not consistent with the preamble. Specifically, the body does not contain a limitation that either obtains, "warranty registration of products" (as there is no warranty information claimed) or expedites "warranty service on defective products".

Claim 5 recites the limitation "said consumer purchaser" and "said point of purchase at retail" in lines 2 and 3 and line 3, respectively. There is insufficient antecedent basis for these limitations in the claim.

Claim 7 recites the limitation "said free return service" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-4,6 and 8-20 are rejected as depending from a rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,2,5-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 5,521,825 to Rose, Jr. (Rose).

As to claim 1, Rose discloses a tracking system for articles (title) providing a unique identifier on or within each item (col 9, lines 13-15), providing a lost and found system with return instructions (col 5, lines 50-53), it would be inherent that the registration plate would have contact information to the company providing the plate else whoever found the item could not contact the issuing company to return to the owner. As the information is provided to the manufacturer (col 6, lines 57-59), it could be used in order to register a warranty.

Rose does not, however, teach offering a reward for returning a lost item. It is very well known in the art to offer a reward for a lost item, especially if the item has value. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Rose by offering a reward to increase the likelihood that the item will be returned.

As to claim 2, Rose discloses a return agent with access to the data (police, col 11, lines 55-60) to facilitate return of the item.

As to claim 4, Rose discloses the item as being purchased retail (col 1, lines 28-31).

As to claim 6, it would be inherent that the data was given when purchasing the item. For instance, Rose discloses the system in relation to automobiles and customer information is given when purchasing automobiles.

As to claim 7, it would be inherent that the information is given when enrolling else the information would not be in the database.

As to claim 8, Rose does not teach using the Internet. Rose does, however, teach using computers (database) and it is very well known in the art to connect computers to the Internet to facilitate the transfer of data. Therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to facilitate the transfer of the data.

As to claim 9, Rose discloses charging for the service (col 13, lines 65-66). It would be obvious to charge the user for any reward offered, as this is generally the responsibility of the owner of the returned merchandise.

As to claim 10, it would be obvious to one of ordinary skill in the art to only charge for the service if a product is lost and then found as the cost of maintaining a database is negligible and this would increase the likelihood of a consumer using the service.

As to claim 11, Rose discloses the plate as being a bar code (col 11, lines 60-61). It is very well known in the art to use parcel service companies (such as UPS) to ship items. It would have been obvious to one of ordinary skill in the art to use a parcel service company to return a lost item as they have the infrastructure to deliver packages

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anywhere. It further would have been obvious to one of ordinary skill in the art to allow shipping companies to use the bar code reader to track the package.

As to claim 18, it would have been obvious to one of ordinary skill in the art to have a message come up on a screen, if the item had a screen, to ensure that the finder of the item would know that it had been lost or stolen.

Claims 3,4 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose as applied to claims 1,2,5-11 and 18 above, and further in view of US PAT 4,818,998 to Apsell et al. (Apsell).

Rose discloses a lost and found system as discussed. Rose does not, however, teach a transmitting device on the object.

Apsell teaches a lost and found system (title) with a transponder (claim 1).

As to claims 3 and 4, Apsell discloses an RFID (transponder T). It would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Rose with the transponder as taught by Apsell to ease the finding of lost and stolen items, as taught by Apsell.

As to claim 13, it would have been obvious to one of ordinary skill in the art to use a sticker transponder as many of the items will be too small for anything larger to be affixed thereon.

As to claim 14, it would have been obvious to one of ordinary skill in the art to use adhesive on the sticker to ensure that it sticks to the item.

As to claim 15, it would have been obvious to one of ordinary skill in the art to use a release liner as this would ensure that the adhesive was not exposed until the item was to be affixed.

As to claim 16, Rose discloses a plate with indicia, as discussed above. It would be inherent that the plate has a place in which to place such indicia.

As to claim 17, Apsell discloses a memory as the signal has a digital code therein (col 4, line 40-42), the device would inherently have memory to be able to transmit the code.

Claims 12,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose in view of Apsell as applied to claims 1-11 and 13-18 above, and further in view of US PAT 5,651,063 to Vorobiev.

Rose in view of Apsell teach a lost and found system as discussed above. They do not, however, teach linking warranty service data.

As to claims 12,19 and 20, Vorobiev discloses a database of purchased vehicles with warranty information (col 7, lines 47-49). It would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Rose with the warranty information as disclosed by Vorobiev as Vorobiev teaches this as important information to be linked to ownership information. Further, it would have been obvious to one of ordinary skill in the art to forward the item to an authorized warranty service center if the item is due for a warranty service.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT 6,792,465 to Welsh, Welsh discloses a lost and found system for pets using tags (304), registering information from the owners (500), and further discloses offering a reward (col 6, lines 66-67), US PAT 6,757,663 to Rogers et al., Rogers et al., disclose an electronic registration system (title) that could be used to track lost items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Fisher



Patent Examiner

MF 
10/18/04